

Additionally, in the Final Action, the Examiner summarily dismissed Applicants arguments as lacking a basis in the claims stating, "Applicants argue that the present claims are directed to an improved cathode including EMD of a specified character. However, it is clear from reading the claims that the product being claimed is 'an improved cathode material and not the cathode itself.'" The Applicants respectfully direct the Examiner's attention to page two, first full paragraph, of Applicants' prior response. Therein the Applicants clearly stated, "[t]he pending claims cover **an improved cathode material** comprising EMD (electrolytic manganese dioxide) with certain characteristics and properties." (emphasis added) Therefore, the Applicants respectfully submit that the previously submitted arguments are based on the currently pending claims.

Section 102 – Anticipation Rejection

Turning now to the rejection of the claims under §102, the Applicants note that "[t]he factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention." Ex parte Levy, 17 U.S.P.Q.2d 1461, 1462 (BPAI 1990). Thus, a §102 rejection of pending claim 17 requires citation of a reference disclosing a cathode material comprising EMD having the characteristics set forth in claim 17. Additionally, it is well settled that prior to placing a burden of comparison on the Applicant, the Examiner must first establish a prima facie basis for denying the claims. Id. at 1463-64. As stated by the Board in Ex parte Levy, the Examiner must "identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Id. at 1462.

In this instance, the Examiner has cited art disclosing the use of EMD. However, the references cited by the Examiner fail to disclose a cathode material comprising EMD having any of the characteristics set forth in any of the pending claims. The detailed discussion of the prior art provided in the Applicants response dated October 4, 2002 is incorporated herein and for the sake of conciseness will not be repeated.

In the Final Action, the Examiner acknowledged that the claims are directed to "an improved cathode material." The improved cathode material **comprises** EMD. As set forth in claim 17, the EMD has a AA-cell discharge capacity at a 1 watt discharge rate of about 68.2 milliamper hours per gram or higher and an AA-cell discharge energy at a 1 watt discharge rate of about 755 milliwatt hours or higher. Thus, the pending claims do not "merely recite an EMD

use” as suggested by the Examiner. Rather, the pending claims are clearly directed to a composition of matter. Specifically, the composition of matter is a cathode material.

The composition of matter claims set forth in the current application are an allowable claim format. The Examiner’s attention is directed to the enclosed copy of the Ex parte Levy decision. This decision concerns two independent claims wherein the claimed subject matter is defined by its physical characteristics. In Ex parte Levy, the claims under consideration by the Board stated:

13. High molecular weight, biaxially oriented, flexible polymeric balloon having a wall tensile strength of at least 31,714 psi (218.86 MPa).

25. High molecular weight, biaxially oriented, flexible polyethylene terephthalate dilation catheter balloon.

The Examiner in Ex parte Levy rejected the claims under §102 and argued that the burden of demonstrating the differences between a reference and the current application falls on the Applicants because the Patent and Trademark Office lacks the equipment necessary for testing. Id. at 1463. The Board reversed the §102 rejection because the Examiner failed to cite a reference disclosing a biaxially oriented balloon. As indicated above, the Board clearly indicated that prior to shifting the aforementioned burden to the Applicants, the Examiner must first satisfy the initial burden of establishing a prima facie basis for denying patentability. Id. at 1463-64.

The currently pending claims are analogous to the claims of Ex parte Levy as they are directed to an improved cathode material comprising EMD having a particular characteristic. The anticipatory rejection in Ex parte Levy was unsupported because the cited failed to disclose a claimed characteristic. Likewise, the art cited in support of the rejection of the currently pending claims fails to disclose a single claimed characteristic of the cathode material. Therefore, the Examiner has not established a prima facie basis to deny the patentability of pending claims 17-25.

Conclusion

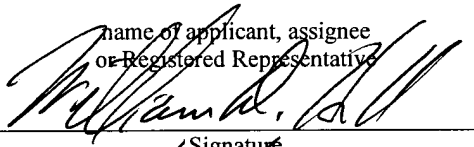
Summarizing the foregoing discussion, the cited art does not anticipate (or render obvious) an improved cathode material comprising EMD having any of the characteristics set forth in the pending claims. Rather, the cited references merely disclose the use of EMD in a cathode. Further,

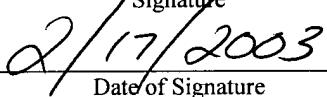
the Final Action did not establish a prima facie basis for either the §102 rejection or the §103 rejection of the pending claims.

In view of the foregoing arguments over the cited art and the basis for the §102 rejection, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the pending claims. A formal Notice of Allowance of Claims 17-25 is earnestly solicited. Should the Examiner care to discuss any aspect of the foregoing response in greater detail, the undersigned attorney would welcome a telephone call.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, D. C. 20231, on February 17, 2003.

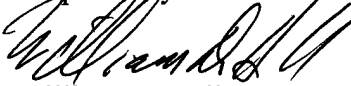
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Date of Signature

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